UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,643	11/18/2003	Peter A. Crooks	069962-0102	2532

22428 7590 07/09/2007

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER
CHONG, YONG SOO

ART UNIT	PAPER NUMBER
1617	

MAIL DATE	DELIVERY MODE
07/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/714,643	CROOKS ET AL.	
	Examiner	Art Unit	
	Yong S. Chong	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-72* is/are pending in the application.

4a) Of the above claim(s) *3,4,10,11,19,20,26,27,32-70 and 72* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-9,12-18,21-25,28-31 and 71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/27/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's response filed on 5/4/2007. Applicant's election **with** traverse of the restriction requirement in the reply is acknowledged. The traversal is on the ground(s) that there is no search burden to examine all of the groups and species together. This is not found persuasive because a search for one group will not lead to another in the non-patent literature. The requirement is still deemed proper and is therefore made FINAL. Claim(s) 1-72 are pending. Claim(s) 1 has been amended. Claim(s) 32-70, 72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claim(s) 3-4, 10-11, 19-20, 26-27 are withdrawn from further consideration as being drawn to a non-elected species. Claim(s) 1-2, 5-9, 12-18, 21-25, 28-31, 71 are examined herein insofar as they read on the elected invention and species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebert et al. (European Journal of Pharmacology, 333, 1997, 99-104).

Ketamine is taught to be a well-known NMDA receptor antagonist and has been used as an analgesic for over 30 years. In sub-anaesthetic doses the analgesic effects of ketamine are thought to be mediated by the blockade of the NMDA receptors. Norketamine is a metabolite of ketamine with similar pharmacological profiles as a NMDA receptor antagonist following an oral or i.m. dose (pg. 99-100). Therefore, norketamine has some analgesic properties. Clinical studies involving oral administration of norketamine and its reduced side effects are now being investigated in humans (pg. 103).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham vs John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 5-9, 12-18, 21-25, 28-31, 71 are rejected under 35 U.S.C. 103(a) as being obvious over Ebert et al. (European Journal of Pharmacology, 333, 1997, 99-104)

as applied to claims 1-2 in view of Harbut et al. (US Patent Application 2005/0148673 A1).

The instant claims are directed to a method of treating neuropathic pain by administering norketamine over a 24-hour period and in conjunction with a narcotic analgesic effective to treat pain.

Ebert et al. teach as discussed above, however fail to disclose the specific dosage and a narcotic analgesic.

Harbut et al. teach treating neuropathic pain by administering a composition comprising NMDA receptor antagonist, such as ketamine (abstract), which can be co-administered with Valium (paragraph 0033). Ketamine can be administered intravenously and subcutaneously (paragraph 0038) and for a sustained period of time, such as two or more consecutive days (paragraph 0057). Ketamine is also disclosed to be metabolically degraded into norketamine, which is about 25% as effective as ketamine (paragraph 0081). Other pain treating drugs, such as morphine and oxycontin, were typically reduced by about 25% on the second day of treatment, while ketamine treatment continued (paragraph 0086). Typical dosage of ketamine is disclosed to be 10 mg/hour (paragraph 0100) or 240 mg per day, which meet the limitation between 0.05 to 8 mg/kg body weight or 3.5 to 1400 mg for an average adult of 70 kg.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted norketamine as

disclosed by Ebert for ketamine in the composition disclosed by Harbut for treating neuropathic pain.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) both norketamine and ketamine are functionally equivalent as NMDA receptor antagonists; (2) both norketamine and ketamine are known in the prior art to have analgesic properties; (3) ketamine breaks down metabolically to norketamine; and (4) norketamine is disclosed to have fewer side effects than ketamine. Therefore, the skilled artisan would have had a reasonable expectation of success in treating neuropathic pain. Furthermore, it is obvious to one of ordinary skill in the art to have self-administered on an outpatient basis norketamine to effectively treat pain because of the convenience and ease of not having to go to the hospital as frequently and for prolonged periods of time.

Examiner notes that the dosage amounts disclosed in the rejection is inherently below a level to induce dysphoria since a composition and its properties are inseparable. It is also obvious that a physician or medical provider would prescribe such dosages so as to limit or reduce as much side effects as possible.

"Products of identical chemical composition can not have mutual exclusive properties." Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The

burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER